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Appl. No. 10/085,379

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Amendment/Response

Reply to Office Action of September 22, 2005

**REMARKS/DISCUSSION OF ISSUES**

Claims 1-24 are pending in this application. No claims are amended.

**Rejections under 35 U.S.C. § 103(a)**

Claims 1-24 are rejected under U.S.C. § 103(a) as being unpatentable over Morimoto et al. in view of Smith III. The rejection of the claims is respectfully traversed.

One of the requirements for a *prima facie* case of obviousness is that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2143. As Section 2143.01 states, the prior art must suggest the desirability of the claimed invention, and the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. The Examiner states that it would have been obvious to modify Morimoto's translation of unknown words via dictionary servers into Smith's predetermined Internet search engine to allow users to add or edit link databases in order for users to have editorial control thus avoiding the result of dictionary websites which tend to offer far less information relative to the index websites.

Unfortunately, the Examiner does not state where in the prior art references this motivation comes from. Scrutiny of the cited references does not reveal that this motivation was recognized by either Morimoto or Smith. Morimoto simply does not recognize the limitations of dictionary websites, which tend to offer far less information relative to the index websites, because when Morimoto can't find a word in its own dictionary, it looks to other dictionaries on the Internet (col. 12, lines 1-6). Morimoto recognizes that this can lead to problems, so an elaborate prioritization scheme is developed (remainder of col. 12). That is, Morimoto recognizes problems with its own methods and devises solutions to them. There is no discussion in Morimoto about looking to a general Internet search rather than looking to a dictionary search, which would further exacerbate the problems that Morimoto is trying to solve. In that sense, Morimoto teaches away from the combination. The Smith reference isn't even about translations or machine translations, but rather is about a method for facilitating linking on the web. As such,

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there is nothing to be found in Smith which provides the motivation to combine which is a necessary part of an obviousness rejection. Therefore, the rejection is invalid.

In addition, Smith and Morimoto are not analogous arts. As the Field of the Invention section of the specification states, the field of the invention is a machine translation system. Morimoto is within the field of the invention, but Smith is not. Smith is not directed, nor does it even mention, any sort of machine translation or any translation at all. There is no "first language" and "second language" in Smith. Smith is in a non-analogous field. Therefore, under MPEP § 2141.01(a), the Examiner cannot combine Smith with Morimoto, and the rejection is invalid.

Furthermore, while it is acknowledged that Smith teaches a predetermined Internet search engine (although not based on the "first language" because Smith doesn't teach first and second languages), Smith does not teach a link setter for the unknown word, because Smith doesn't have any unknown words. This is because Smith is not directed to machine translations, so the concept of unknown word as defined in the specification (page 2, lines 6-9) does not exist in Smith. Therefore, even combining Smith with Morimoto does not yield the claimed invention because of the missing feature, "a link setter for setting a link for said unknown word in said first language."

For these three reasons, (1) lack of motivation within the reference, (2) trying to combine non-analogous references, and (3) the combination still not producing the claimed invention, Applicants respectfully suggest that the rejection is overcome. Reconsideration of the rejection of claims 1-24 under U.S.C. § 103(a) is respectfully requested.

In view of the foregoing, Applicants respectfully request that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application in condition for allowance. If any points remain in issue that may be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated or by e-mail directed to Chris@PatentingServices.com.

Respectfully submitted,

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